

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

Claims 1 and 6-17 were pending in this application. In this response, claim 1 has been amended to address a grammatical matter. Thus, claims 1 and 6-17 remain pending.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 6 to 13 and 15 to 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,475,307 to Nystrom (hereafter "*Nystrom*") in view of U.S. Patent No. 5,241,748 to Ishida (hereafter "*Ishida* '748") or U.S. Patent No. 5,308,089 to Ishida (hereafter "*Ishida* '089") on the grounds set forth at paragraph 2 of the Official Action. Claim 14 is rejected under 35 U.S.C. §103(a) as being anticipated by *Nystrom* in view of "*Nystrom*" in view of "*Ishida* '748" or "*Ishida* '089" as applied to claims 1, 6 to 13 and 15 to 17 above, and further in view of WO 01/79585 (hereafter "*WO* '585") and on the grounds set forth at paragraph 8 of the Official Action. Each of these rejections is respectfully traversed.

First, it is respectfully noted that the *Nystrom* reference only qualifies as prior art under 35 U.S.C. § 102(e).

U.S. Patent No. 6,475,307 to Nystrom issued as a patent on November 5, 2002, based on an application filed on November 16, 2000. No application publication information is listed on the front page of *Nystrom*.

The present application is a national stage filing of PCT/SE2003/001159, designated the United States, was filed in the International Bureau on July 2, 2003, and claims the benefit of priority of SE 0202107-9, filed in Sweden on July 3, 2002. Applicants submit herewith an certified copy of the foreign priority document SE 0202107-9 with the purpose of perfecting the priority claim. See MPEP §§ 201.13-15 and 706.02(b). Please note the priority document was filed and published in the English language.

Comparing the issued date of U.S. Patent No. 6,475,307 to Nystrom, i.e., November 5, 2002, to the perfected priority date of the present application, i.e., July 3, 2002, it is clear that U.S. Patent No. 6,475,307 to Nystrom issued after the filing date. Thus, the only statutory basis by which the *Nystrom* reference is prior art to the present application is under 35 U.S.C. § 102(e).

Second, the rejections are respectfully traversed because the use of the *Nystrom* reference in an obviousness-type rejection is improper.

As noted above, *Nystrom* is available as prior art in the United States only under 35 U.S.C. § 102(e).

However, use of this reference in any obviousness-based rejection of Applicants' present claims is improper, because it is commonly assigned to the assignee of the present application. See 35 U.S.C. § 103(e) (stating that subject matter developed by another which qualifies as prior art only under one or more of subsections (e), (f), and (g) of § 102, shall not preclude patentability).

Per MPEP §706.02(1)(2), the *Nystrom* patent can be removed as a reference by an affidavit or statement of common ownership at the time of the invention of the present application.

Accordingly, Applicants provide the following statement:

U.S. Patent Application No. 10/519,711 and U.S. Patent No. 6,2475,307 B1 were, at the time U.S. Patent Application No. 10/519,711 was made, commonly owned by or under an obligation of assignment to SANDVIK AB.

Applicants note that subsequently, both U.S. Patent Application No. 10/519,711 and U.S. Patent No. 6,2475,307 B1 are now owned by Sandvik Intellectual Property AB.

Since the *Nystrom* patent is no longer available as prior art in an obviousness rejection against the application, Applicants respectfully request the withdrawal of all the rejections, each of which relies at least in part on the *Nystrom* reference. Accordingly, all pending claims are considered allowable over the cited references.

CLAIM OBJECTIONS

Claim 1 was objected to for the reasons appearing at paragraph 11 of the Official Action. The grammatical error in claim 1 has been corrected. Reconsideration is respectfully requested.

SPECIFICATION OBJECTIONS

The specification was objected to as noted at paragraph 12. The noted term “tenifer” is not a typographical error. Rather, tenifer is a metal working process in which an object is nitrided in a salt bath. Reconsideration of the objection is respectfully requested.

Also, the objection was referenced to using the pages from the WO publication. However, a substitute specification was submitted in this application. Applicants wish to confirm that the substitute specification was received and entered in this application.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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